

REMARKS

Claims 1-20 are currently pending in the present application. Claims 1-20 stand rejected. No claims have been amended, added, or canceled. Reconsideration of claims 1-20 in light of the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 3-5, 8-12, 14, 16-17, and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,836,529 to Gibbs. Applicants respectfully traverse the rejection.

Claim 1 is directed to a method for inspecting rail equipment and storing information relating to the inspection. Among other limitations, claim 1 requires providing a plurality of dispositions for the rail equipment wherein at least one of the dispositions comprises repairing the rail equipment using a mobile repair unit and assigning one of the plurality of dispositions to the rail equipment based on the overall damage condition of the rail equipment. As correctly noted by the Examiner, Gibbs fails to show the steps of “providing a plurality of dispositions” and assigning one of the plurality of dispositions to the rail equipment “based on the overall damage condition of the rail equipment.” *See* Office Action dated December 12, 2005, Pg. 3.

However, the Examiner maintains that it would have been obvious to provide a plurality of dispositions and assign one of the plurality of dispositions to the rail equipment based on the overall damage condition of the rail equipment because “Gibbs is directed to railroad transportation monitoring and management system and method by detecting, assigning status, and monitoring a set of real time identification, and display characteristics for the set of transports within the transportation network and generating an output display characterizing relationships. Applicants respectfully disagree that such a modification would have been obvious.

The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *See In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). Even when obviousness is based on a single prior art reference, as is the case here, there must be a

showing of a suggestion or motivation to modify the teachings of the reference. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Applicants submit that Gibbs does not possess the motivation to support the modification suggested by the Examiner.

Gibbs discloses a transportation network management system that generates various outputs, such as graphical displays showing the location of rail equipment, including terminals and rail cars on a map and reports displaying a variety of information relating to rail equipment. One type of report that can be displayed is a train report 414 having information regarding a rail car. *See* Gibbs, Col. 15, Ins. 60 – Col. 17, Ins. 13. Although the train report can include damage information such as quality inspection and mechanical failure codes, the reported damage information is simply a recitation of damage information inputted in the system by a user. *See* Gibbs, Col. 15, Ins. 48-49. Gibbs does not disclose, teach, or suggest providing a plurality of dispositions for the rail equipment and assigning a disposition to the rail equipment based on the overall damage condition of the rail equipment. In fact, Gibbs does not even suggest that repair information can be determined and provided in the train report 414. Rather, Gibbs only discloses that damage condition information is recited.

Conversely, claim 1 requires the steps of providing a plurality of dispositions for the rail equipment and assigning one of the plurality of dispositions to the rail equipment based on the overall damage condition of the rail equipment. As noted in the specification, a user enters information, such as damage to the rail car, and the generic information relating to each type of railcar, into the data entry system via step 34. After the information has been entered, the system determines the type of repair disposition that should take place, such as whether the railcar should be shopped, whether a mobile repair unit should be dispatched, or whether the railcar can be sent directly to the customer. The system determines the type of repair disposition that should take place based on the overall damage condition of the rail equipment. Based on this determination, the system generates a “Repair Disposition” report assigning the determined type of repair disposition that should take place. *See* Application, Pg. 9, Ins. 1-24.

Gibbs does not disclose, teach, or suggest a system that determines the type of repair disposition that should take place based on the overall damage condition of the rail equipment. Logically, Gibbs does not disclose, teach, or suggest a system that generates a “Repair Disposition” report, based on the determination, and assigning the determined type of repair disposition that should take place. As a result, there is no motivation to modify claim 1 as suggested by the Examiner, and claim 1 is not obvious in view of Gibbs.

As a result, Applicants respectfully submit that Claim 1 is patentable over Gibbs. Additionally, claims 3-5 and 8-11 depend on claim 1, and include all of its limitations. Therefore, Applicants respectfully submit that claims 3-5 and 8-11 are also patentable over Gibbs.

Similarly, Applicants respectfully submit that claim 12 is patentable over Gibbs. Claim 12 is directed to a data entry system for inputting information related to an inspection of rail equipment wherein the rail equipment comprises a plurality of parts. Among other limitations, claim 12 requires “means for assigning a disposition from a plurality of dispositions based on the overall damage condition of the rail equipment wherein at least one of the plurality of dispositions comprises assigning a mobile repair unit to repair damage to the rail equipment.” As correctly noted by the Examiner, Gibbs fails to disclose this limitation. *See* Office Action dated December 12, 2005, Pg. 3.

As noted with respect to claim 1, Gibbs discloses a transportation network management system that generates various reports, including a train report 414 having information regarding a rail car. *See* Gibbs, Col. 15, Ins. 60 – Col. 17, Ins. 13. The train report 414 includes a recitation of damage information, such as quality inspection and mechanical failure codes, that is inputted in the system by a user. *See* Gibbs, Col. 15, Ins. 48-49. Gibbs does not disclose, teach, or suggest a means for assigning a disposition from a plurality of dispositions based on the overall damage condition of the rail equipment wherein at least one of the plurality of dispositions comprises assigning a mobile repair unit to repair damage to the rail equipment. Indeed, Gibbs does not even suggest that repair information can be determined and provided in the train report 414. Rather, Gibbs only discloses that damage condition information is recited. Therefore, Applicants submit that there is no motivation to modify claim 12 as suggested by the Examiner, and claim 12 is not obvious in view of Gibbs.

As a result, Applicants respectfully submit that Claim 12 is patentable over Gibbs. Additionally, claims 14, 16-17, and 19-20 depend on claim 12, and include all of its limitations. Therefore, Applicants respectfully submit that claims 14, 16-17, and 19-20 are also patentable over Gibbs.

The Examiner has also rejected claims 2, 6-7, 13, 15, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Gibbs in view of U.S. Patent No. 6,345,257 to Jarrett. Applicants respectfully traverse the rejection.


As noted above, Applicant's submit that independent claims 1 and 12 are patentable over Gibbs. Claims 2-6, 13, 15, and 18 depend on either claims 1 or 12, and include all the limitations of their respective independent claims. Therefore, Applicants respectfully submit that claims 2-6, 13, 15, and 18 are patentable for the same reasons that claims 1 and 12 are patentable, and request allowance of the same.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the currently pending claims are in allowable form and that the application is in condition for allowance. Reconsideration and reexamination of the pending claims is requested. If for any reason the Examiner is unable to allow the application and feels that an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney at (312) 372-2000.

Respectfully submitted,

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